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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,934	06/03/2002	Gour Mukherji	RLL-165US	3005
26815	7590	12/29/2004	EXAMINER	
			YOUNG, MICAH PAUL	
		ART UNIT		PAPER NUMBER
		1615		

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/936,934	MUKHERJI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Micah-Paul Young	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 September 2004.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

**Acknowledgment of Papers Received:** Amendment/Response filed 09/20/04.

### *Claim Objections*

1. Claim 2 is objected to for being dependent from a canceled claim. The examiner will prosecute the claim on its merits, as if it were dependent from claim1. Proper amendment of this claim is necessary.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,3-15, 17 and 18 rejected under 35 U.S.C. 102(b) as being anticipated by Bai (USPN 5,840,329 hereafter '329).
3. The '329 patent discloses a pharmaceutical formulation comprising a coating composition. The coating composition comprises combinations of film-forming polymers such as cellulose (mono-, di-, or tri-) alkanylate (col. 9, lin. 27), and swellable polymers such as Carbopol (col. 9, lin. 54-56). The composition further comprises lubricants, and other common excipients such as talc (col. 10, lin 15). The components are present in concentrations from 0.16-8%, well within the ranges recited in the claims (examples). The coating composition further

comprises plasticizers such as triethylcitrate (example 7). These disclosures continue to anticipate the claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined disclosures of Bai (USPN 5,840,329 hereafter '829) and Jain et al (USPN 4,610,870 hereafter '870).

7. As discussed above the '829 discloses a coating composition comprising film-forming polymers, water-swellable polymers, and further excipients. The reference however does not recite the same plasticizers as recited in claims 16 and 17. However polyethylene glycol is well known in the art as a plasticizer as seen in '870.

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8. The '870 patent discloses an oral pharmaceutical preparation comprising a core with a coating (col. 4, lin. 21-29). The coating comprises film forming material (col. 6, lin. 34 – 46), as well as swellable polymers (col. 6, lin. 47 – 52). The formulation further comprises lubricants, channeling agents and plasticizers (col. 6, lin. 11 – 24; col. 7, lin. 20 – 23, lin. 34 – 49). The lubricants include talc, and the plasticizers include polyethylene glycol (*Ibid.*). It would have been obvious to a skilled artisan to include the polyethylene glycol of '870 in order to insure the proper release of the active agents.

Regarding claim 17, it is the position of the examiner that these limitations do not impart patentability on the claims, since the general conditions of claims have been met by the prior art. Applicant is reminded that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

9. With these things in mind it would have been obvious to a skilled artisan to combine the plasticizers of '870 into the coating composition of '329 in order to impart controlled release properties onto the formulation. The '870 patent establishes the equivalency between the plasticizers used in '329 and the polyethylene glycol used in '329. A skilled artisan would be

able to make the substitution in order to impart the particular plasticizing properties of PEG. It would have been obvious combine the teachings as such with an expected result of a coating composition useful in imparting a controlled release profile onto a core particle.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

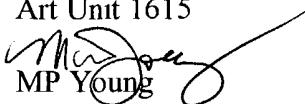
***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 571-272-0608. The examiner can normally be reached on M-F 7:00-4:30 every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Micah-Paul Young  
Examiner  
Art Unit 1615

  
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